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09/575,707	07/20/2000	David Greenblatt	194701US30	5304

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EXAMINER

NGUYEN, QUANG N

ART UNIT PAPER NUMBER

2141

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/575,707

Filing Date: July 20th, 2000

Appellant(s): GREENBLATT, DAVID.

Michael R. Casey

For Appellant

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Examiner's Answer

This is in response to the appeal brief filed 06/13/2005.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences, which will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

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(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

A statement that claims of the following groups of claims should not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8) is contained in the brief.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal:

- Fedorov et al. (US 6,047,060) issued 04/04/2000.
- Voit (US 6,104,711) issued 08/15/2000.
- Venkatachary et al. (US 6,212,184) issued on 04/03/2001.
- DeGolia, Jr. et al. (US 6,411,150) issued on 06/25/2002.
- Haituka et al. (US 6,505,201) issued on 01/07/2003.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1, 3, 5, 7, 11, 13, 16, 20, 22-23 and 28-54 are presented for examination.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1, 3, 5, 7, 11, 13, 16, 20, 22-23, 31-33, 40-45 and 49-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Voit (US 6,104,711), in view of Haitsuka et al. (US 6,505,201), hereafter referred as Haitsuka, and further in view of DeGolia, Jr. et al. (US 6,411,615), hereafter referred as DeGolia.**

4. As to claims 1, 5 and 11, Voit teaches a method and system for translating textual domain names into telephone numbers, comprising:

obtaining a name address (*i.e., obtaining a URL corresponding to a web page*) and transmitting a name translation request or "query" to the domain name server (**Voit, C9: L4-16**);

converting the name address (*i.e., converting the obtained URL*), without user intervention, into a telephone number corresponding to a location at which a provider of the Web page can be contacted (*after receiving the domain name query, the domain name server executes a direct look-up table based translation, wherein certain translations of domain names will result in a response or reply message containing a destination telephone number*) (**Voit, C4: L29-30, C9: L4-16 and C10: L9-20**).

However, Voit does not explicitly teach that obtaining the URL from an address bar of a web browser corresponding to a web page being displayed to a user and visually identifying that the telephone number is known for the URL corresponding to the web page being displayed to the user.

In a related art, Haitsuka teaches a method and system for monitoring the online activities, wherein URLs in the address bar of the browser application are obtained by the monitoring application (**Haitsuka, Abstract and C8: L16-30**).

In another related art, DeGolia teaches a method and system for enabling Data Network Telephony (DNT) communication through a web page, wherein one or more web pages provided and hosted by server 28 include one or more links to embedded IP telephony software on a displayed page. By selecting/clicking such a link appearing as icon or text on a displayed page (*i.e., visually identifying the link/URL as the contact information for the displayed web page*), an IP call is placed to an agent of a company representing a product or service advertised on or otherwise associated with the web page (*a call is made to the telephone number is known for the link/URL corresponding to the web page being displayed to the user*) (**DeGolia, C5:L52 – C6:L7**).

Therefore, it would have been obvious to one having ordinary skills in the art at the time the invention was made to combine the teachings of Voit, Haitsuka and DeGolia to obtain the URL from an address bar of a web browser corresponding to a web page being displayed to a user and visually identify that the telephone number is known for the URL corresponding to the web page being displayed to the user since such methods were conventionally employed in the art to monitor online activities (*i.e., wherein URLs in the address bar of the browser application obtained by the monitoring application*) (**Haitsuka, Abstract, C8: L16-30**) and to provide the contact information (*e.g., the telephone number converted from the name address of Voit, or the embedded IP phone module in such interactive web pages of DeGolia*) allowing the system to enable customer/agent interactions in conducting advertising/business associated with the web pages through the provided contact links/information (**DeGolia, C8: L42-45**).

5. As to claims 3, 7 and 13 Voit-Haitsuka-DeGolia teaches the invention as in claims 1, 5 and 11, further comprising controlling a telephone switch to dial the telephone number (**Voit, C13:L52 – C14:L16 and DeGolia, C5:L61 – C6:L7**).

6. As to claims 16, 20 and 22-23, Voit-Haitsuka-DeGolia teaches the invention as in claims 1 and 5, further comprising establishing a voice-over-IP voice communication connection across a WAN or the Internet (*as in Fig. 1 of Voit and in Fig. 2 of DeGolia*) between the user-side and a web page provider-side (**Voit, C13:L52 – C14:L16 and DeGolia, C5:L61 – C6:L7**).

7. As to claim 31-33, Voit-Haitsuka-DeGolia teaches the invention as in claims 1, 5 and 11, further comprises obtaining a current URL as each new web page is viewed **(Haitsuka, Abstract and C8: L16-65).**

8. As to claims 40-45, Voit-Haitsuka-DeGolia teaches the invention as in claims 1, 5 and 11 further comprises obtaining the telephone number from a local database (*i.e., the domain name processing application 73 executes code to access to translation table 77 and routing control records 81 stored in a database within the storage system portion of the domain name server 51*) **(Voit, Fig. 2 and C9: L48-55);** or from a remote database (*“Official Notice” is taken that both concept and advantages of employing a remote database to store information are conventionally well known and obvious to one having ordinary skills in the art at the time the invention was made*).

9. As to claims 49-51, Voit-Haitsuka-DeGolia teaches the invention as in claims 1, 5 and 11, further comprises establishing a voice communications channel between the user side and a web page provider-side using the telephone number **(Voit, C13:L52 – C14:L16 and DeGolia, C5:L61 – C6:L7).**

10. Claims 52-54 are corresponding claims of claims 1, 5 and 11; therefore, they are rejected under the same rationale.

11. Claims 28-30 and 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Voit-Haitsuka-DeGolia, and further in view of Venkatachary et al. (US 6,411,615), herein after referred as Venkatachary.

12. As to claims 28-30 and 46-48, Voit-Haitsuka-DeGolia teaches the invention as in claims 1, 5 and 11, but does not explicitly teach obtaining, from a database, a longest matching sub-string of the URL without requiring a complete match of the URL to be found in the database, wherein the longest matching sub-string comprises a longest matching prefix.

In a related art, Venkatachary teaches a system and method of routing data, wherein a router database stores address prefixes to which an address (*or a URL*) can be matched to and the forwarding should occur using the most specific longest prefix match (**Venkatachary, C3:L65 - C4:L23 and C5: L60-65**).

Therefore, it would have been obvious to one having ordinary skills in the art at the time the invention was made to implement the invention of Voit-Haitsuka-DeGolia with the idea of longest prefix matching to relate two pieces of data as taught by Venkatachary, since such methods were conventionally employed in the art to allow the system to avoid bottlenecks at high speeds in performing the address lookup and/or in searching string/sub-string for the most specific, most relevant information (*i.e., domain name address, destination IP address, URL, etc.*) in order to optimize the process of forwarding/switching a message in network communications (**Venkatachary, C3: L28-34**).

13. Claims 34-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Voit-Haitsuka-DeGolia, and further in view of Fedorov et al. (US 6,047,060), herein after referred as Fedorov.

14. As to claims 34-39, Voit-Haitsuka-DeGolia teaches the invention as in claims 1, 5 and 11, but does not explicitly teach the step of visually identifying by causing an icon to flash or change color.

In a related art, Fedorov teaches a system and method for enabling full interactive monitoring of calls to and from a call-in center, wherein an audio signal, a flashing icon, or other alert (*i.e., visual identifying by causing an icon to flash or change color*) on the desktop might indicate an agent or agents being in a telephone session and also, by clicking on that active icon, the supervisor will be able to monitor, to join/participate in the telephone session (**Fedorov, C8: L40-53**).

Therefore, it would have been obvious to one having ordinary skills in the art at the time the invention was made to implement the invention of Voit-Haitsuka-DeGolia with the idea of visually identifying by causing an icon to flash or change color as taught by Fedorov, since such methods were conventionally employed in the art of network monitoring to catch the attention of the user in order to alert/notify the user that some function/feature is going on or ready for the user to execute.

(11) Response to Arguments

In the Remarks, the Applicant argued in substance that

(A) The Applicant argued that “there is no motivation to combine the ‘711 Patent with either the ‘201 Patent or the ‘615 Patent, the outstanding Office Action has engaged in improper hindsight reconstruction using teachings from the appellant’s own specification”.

As to point (A), in response to applicant’s argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, **Voit** (**‘711**) teaches obtaining a name address (obtaining a URL), transmitting a name translation request or “query” to the domain name server (**Voit, C9: L4-16**); and converting the name address (converting the URL corresponding to a web page), without user intervention, into a telephone number corresponding to a location at which a provider of the Web page can be contacted (*after receiving the domain name query, the domain name server executes a direct look-up table based translation, result in a response with a telephone number*) (**Voit, C4: L29-30, C9: L4-16 and C10: L9-20**).

In a related art, **Haitsuka ('201)** teaches a method and system for monitoring the online activities, wherein URLs in the address bar of the browser application are obtained by the monitoring application (Haitsuka, Abstract and C8: L16-30).

In another related art, **DeGolia ('615)** teaches a method and system for enabling Data Network Telephony communication through a web page, wherein one or more web pages provided and hosted by server 28 include one or more links to embedded IP telephony software on a displayed page. By selecting/clicking such a link appearing as icon or text on a displayed page (i.e., visually identifying the link/URL as the contact information for the displayed web page), an IP call is placed to an agent of a company representing a product or service advertised on or otherwise associated with the web page (a call is made to the telephone number is known for the link/URL corresponding to the web page being displayed to the user) (DeGolia, C5:L52 – C6:L7).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Voit, Haitsuka and DeGolia to obtain the URL from an address bar of a web browser corresponding to a web page being displayed to a user and visually identify that the telephone number is known for the URL corresponding to the web page being displayed to the user since such methods were conventionally employed in the art to monitor online activities (*i.e., wherein URLs in the address bar of the browser application obtained by the monitoring application*) (**Haitsuka, Abstract, C8: L16-30**) and to provide the contact information (*e.g., the telephone number converted from the name address of Voit, or the embedded IP phone module in such interactive web pages of DeGolia*) allowing the system to

enable customer/agent interactions in conducting advertising/business associated with the web pages through the provided contact links/information (**DeGolia, C8: L42-45**).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

(B) The Applicant argued that "the Office Action attempts to overcome the deficiency by citing two additional references, i.e., the '201 and '615 patents".

As to point (B), in response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

Besides, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

(C) The Applicant argued that “the applied combination of the ‘711 Patent, the ‘201 Patent and the ‘615 Patent changes the principle of operation of the references”.

As to point (C), In response to applicant's argument that “the applied combination of the cited references changes the principle of operation of the references”, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

(D) The Applicant argued that “there is no Prima Facie case of obviousness because the applied combination does not teach all of the claim limitations of independent claims 1, 5, 11 and 52-54”.

As to point (D), please see the rejection in paragraph 4 on pages 4-6 and the response to argument in point (A) on page 10 above.

(E) The Applicant argued that “the applied combination of the ‘711 Patent, the ‘201 Patent, the ‘615 Patent and the ‘184 Patent does not provide a Prima Facie case of obviousness, i.e., does not provide features identified in claims 28-30 and 46-48”.

As to point (E), again in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can

only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Voit-Haitsuka-DeGolia teaches the invention as in claims 1, 5 and 11, but does not explicitly teach obtaining, from a database, a longest matching substring of the URL without requiring a complete match of the URL to be found in the database, wherein the longest matching sub-string comprises a longest matching prefix.

In a related art, Venkatachary (**'184 Patent**) teaches a system and method of routing data, wherein a router database stores address prefixes to which an address (*or a URL*) can be matched to and the forwarding should occur using the most specific longest prefix match (**Venkatachary, C3:L65 - C4:L23 and C5: L60-65**).

Therefore, it would have been obvious to one having ordinary skills in the art at the time the invention was made to implement the invention of Voit-Haitsuka-DeGolia with the idea of longest prefix matching to relate two pieces of data as taught by Venkatachary, since such methods were conventionally employed in the art to allow the system to avoid bottlenecks at high speeds in performing the address lookup and/or in searching string/sub-string for the most specific, most relevant information (*i.e., domain name address, destination IP address, URL, etc.*) in order to optimize the process of forwarding/switching a message in network communications (**Venkatachary, C3: L28-34**).

(F) The Applicant argued that “the ‘184 Patent is not analogous art”.

As to point (F), In response to applicant's argument that the ‘184 Patent is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

In this case, Venkatachary (**‘184 Patent**) teaches a system and method of routing data, wherein a router database stores address prefixes to which an address (*such as Web URLs*) can be matched to and the forwarding should occur using the most specific longest prefix match (**Venkatachary, C3:L65 - C4:L23 and C5: L60-65**). Since the teachings of Venkatachary is not limited for use with specific fields and can use other fields, including application layer fields such as Web URLs, hence the ‘184 Patent is an analogous art.

(G) The Applicant argued that “the applied combination of the ‘711 Patent, the ‘201 Patent, the ‘615 Patent and the ‘060 Patent does not provide a Prima Facie case of obviousness, i.e., does not provide features identified in claims 34-39”.

As to point (G), again in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce

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the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Voit-Haitsuka-DeGolia teaches the invention as in claims 1, 5 and 11, but does not explicitly teach the step of visually identifying by causing an icon to flash or change color.

In a related art, Fedorov (**'060 Patent**) teaches a system and method for enabling full interactive monitoring of calls to and from a call-in center, wherein an audio signal, a flashing icon, or other alert (*i.e., visual identifying by causing an icon to flash or change color*) on the desktop might indicate an agent or agents being in a telephone session and also, by clicking on that active icon, the supervisor will be able to monitor, to join/participate in the telephone session (**Fedorov, C8: L40-53**).

Therefore, it would have been obvious to one having ordinary skills in the art at the time the invention was made to implement the invention of Voit-Haitsuka-DeGolia with the idea of visually identifying by causing an icon to flash or change color as taught by Fedorov, since such methods were conventionally employed in the art of network monitoring to catch the attention of the user in order to alert/notify the user that some function/feature is going on or ready for the user to execute.

Examiner has considered all of applicant's arguments.

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For the above reasons, it is believed that the rejections should be sustained.

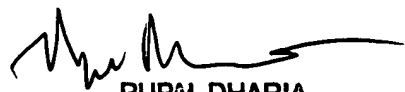
Respectfully submitted,

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August 11, 2005

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